REMARKS

None of the claims is currently amended. Claims 1-33 are pending.

Claims 5-33 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Applicant respectfully traverses.

In *In re Clement*, the Federal Circuit described a three-step approach to applying the recapture doctrine. The first step is to determine in which aspect the reissue claim is broader than the patent claim. 131 F.3d 1464, 1468 (Fed. Cir. 1997). Here, claims 5-33 are the reissue claims, added by a preliminary amendment filed on November 9, 2001. Claims 5-27 are directed to a computer network, while claims 28-33 are directed to a computer readable medium. Claim 5 reads:

> A computer network supporting one or more processes involving transmission of large amounts of data, the computer network comprising:
> an administrator node, adapted to allocate nodal maximum bandwidths for one or more nodes of the network and to communicate to the one or more nodes the respective allocated nodal maximum bandwidths; and
> a client node, adapted to receive an allocated nodal maximum bandwidth from the administrator node, and further adapted to determine current values of a set of variables related to bandwidth usage by the one or more processes at the client node and to communicate the current values to the administrator node, wherein the administrator node utilizes the current values to adjust the allocated nodal maximum bandwidths for the one or more nodes.

The patent upon which the present reissue is based has four claims. Claims 1 and 2 are directed to a method, while claims 3 and 4 are directed to a system. Claim 1 reads:

> In a computer network comprising nodes, a method of administering sending of teleconference data over the network comprising:
> determining an allocated bandwidth corresponding to the sending;
> communicating the allocated bandwidth to the nodes;
> inhibiting use of bandwidth by any of the nodes in excess of the allocated bandwidth;
> monitoring at least one nodal happiness factor; -

adjusting the allocated bandwidth in response to the at least one
nodal happiness factor;
dynamically measuring bandwidth use of program elements at a node; and
assigning bandwidth among program elements, such that the total of
assigned bandwidth is not greater.than said allocated band-
width.

Reissue claim 5 is broader than patent claim 1 in two aspects. First, the preamble of reissue claim 5 recites "large amounts of data" while the preamble of patent claim 1 recites "teleconference data." Second, reissue claim 5 recites "further adapted to determine current values of a set of variables related to bandwidth usage by the one or more processes at the client node" while patent claim 1 recites "dynamically measuring bandwidth use of program elements at a node; and assigning bandwidth among program elements, such that the total of assigned bandwidth is not greater than said allocated bandwidth."

The second aspect involves the amount of bandwidth used by program elements (e.g., processes or applications) operating at a node. (15:24-51) Patent claim 1 recites measuring this bandwidth for each program element and then allocating bandwidth among program elements. Reissue claim 5, however, recites merely determining the bandwidth; it does not recite assigning bandwidth among program elements.

The second step in *In re Clement* is to determine whether the reissue claim's broader aspect is related to surrendered subject matter. *Clement* at 1468-69. The first aspect, that of "large amounts of data," is not present anywhere in the prosecution history of the patent upon which the present reissue is based. Thus, applicant has not surrendered this broader aspect.

In paper No. 11 of the parent case, claims 4-6 and 9-12 were cancelled. Claims 4-6 and 9 were directed to a method, while claims 10-12 were directed to a system. At the time that it was cancelled, claim 4 read:

> In a computer network comprising nodes, a method of administering sending of teleconference data over said network comprising the steps of:
>   determining an allocated bandwidth corresponding to said sending;
>   communicating said allocated bandwidth to said nodes;
>   inhibiting use of bandwidth by any of said nodes in excess of said allocated bandwidth;
>   monitoring at least one nodal happiness factor; and
>   adjusting the allocated bandwidth in response to the at least one nodal happiness factor.

Thus, cancelled claim 4 is identical to patent claim 1 except that it does not contain the last two limitations of dynamically measuring bandwidth and assigning bandwidth. Although Applicant did not admit that the scope of claim 4 was not patentable, a court may draw an inference to that effect based on changes in claim scope when other reliable evidence of the patentee's intent is not available. *Ball Corp. v. United States*, 729 F.2d 1429, 1436 (Fed. Cir. 1984).

The third step in *In re Clement* is to determine whether surrendered subject matter has crept into the reissue claim. *Clement* at 1469. If the scope of the reissue claim is the same as or broader than that of the cancelled claim, then the reissue claim is unallowable. *Ball* at 1436. In contrast, a reissue claim narrower in scope escapes the recapture rule entirely. *Id.*

Here, reissue claim 5 is broader than cancelled claim 4 in one aspect and narrower than cancelled claim 4 in another aspect. Reissue claim 5 is broader because it recites "large amounts of data" while cancelled claim 4 recites "teleconference data." Reissue claim 5 is narrower because it recites "further adapted to determine current values of a set of variables related to bandwidth usage by the one or more processes at the client node" while cancelled claim 4 does not recite anything related to bandwidth usage by processes.

If the reissue claim is narrower in an aspect germane to a prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.

Clement at 1470. In paper No. 10 of the parent case, the Examiner rejected claim 4, stating that Marshall showed each of the claimed elements. Examiner also stated that claim 7 would be allowable if rewritten in independent form, since the prior art of record did not teach the claimed elements of dynamically measuring bandwidth and assigning bandwidth (claim 7). Thus, the prior art rejection was related to the amount of bandwidth used by program elements operating at a node.

In the pending office action, the Examiner stated that the broadening aspect of the reissue relates to subject matter that applicant previously surrendered during the prosecution of the parent application. Applicant respectfully traverses. The broadening aspect of the reissue relates to "large amounts of data" versus "teleconference data" and is not related to the prior art rejection, as explained above.

The narrower aspect of reissue claim 5 is related to the prior art rejection mentioned above. However, since reissue claim 5 recites "further adapted to **determine current values of a set of variables related to bandwidth usage by the one or more processes at the client node**" and cancelled claim 4 does not recite "bandwidth usage by processes," claim 5 is narrower than claim 4 and thus is not barred by the recapture rule.

Similarly, reissue claim 28 recites "determining current values of a set of variable related to bandwidth usage by the one or more processes at the client node" and is also not barred by the recapture rule for at least the foregoing reasons. The claims not specifically mentioned above depend from either claim 5 or claim 28 and thus cannot be broader in scope than claim 5 or claim 28. These claims, therefore, are also not barred by the recapture rule for at least the foregoing reasons.
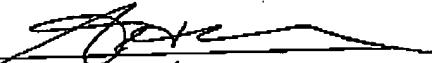
Accordingly, Applicant respectfully submits that claims 5-33 are patentable and are not barred by the recapture rule. On the basis of the above arguments, consideration of this application and the early allowance of all claims herein are requested.

Respectfully submitted,
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